

REMARKS

Applicant hereby traverses the rejection of record and requests reconsideration and withdrawal of such in view of the remarks contained herein. Claims 1-12 and 14-20 are pending in this application. Claims 7-12 and 14-20 are allowed. Claims 2, 3, and 6 are objected to, and claims 1, 4, and 5 are rejected.

Rejection Under 35 U.S.C. § 103(a)

Claims 1, 4, and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,650,748 to Johnston et al (hereinafter "Johnston") in view of U.S. Patent No. 6,396,349 to Taikei et al (hereinafter "Taikei").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding that the second criteria is satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the first or third criteria.

Lack of Motivation

In the Current Action, the Examiner opines that it would have been obvious to replace the amplifier of Taikei with the amplifier of Johnston, "since such a modification would have imparted the advantageous benefit of [a] temperature stable amplifier circuit." *See* Current Action, pgs. 2-3. However, if the proposed modification would render the invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the case at hand, the Examiner introduces Johnston in an attempt to modify Taikei so that its amplifiers would have an input connected to a primary conductor and an output connected to an auxiliary conductor, where the conductors are inductively coupled. *See* Current Action, pg. 2. However, such a modification would destroy the functionality of Taikei's circuit. Taikei provides a power combiner circuit where amplifiers are connected to

branch circuits at input and combiners at output. *See* Taikei at Figure 1. An output of a first combiner is coupled to the input of subsequent combiner such that a traveling wave moving there between is combined. Clearly, if the branch circuits and combiners of Taikei were inductively coupled, the circuit of Taikei would not be functional at all. In particular, the gain desired by Taikei's circuit could not be achieved. As such, the Examiner's proposed modification would render Taikei ineffective. Therefore, there is no suggestion or motivation to make the Examiner's proposed modification.

Applicant further points out that the Examiner's statement of motivation is insufficient according to M.P.E.P. § 2143. It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. *See* M.P.E.P. §2143.01. The language of the recited motivation, namely, "such a modification would have imparted the advantageous benefit of [a] temperature stable amplifier circuit," is circular in nature. The Examiner's assertion merely states that it is obvious to make the modification because it is obvious to achieve the result. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 913 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. §2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification. No valid suggestion has been made as to why a combination of Johnston and Taikei is desirable. Therefore, the rejection of claims 1, 4 and 5 should be withdrawn.

Failure to Teach or Suggest Every Claim Limitation

Claim 1 recites "first non-inverting amplification component with an input connected to said primary conductor and an output connected to said first auxiliary conductor." As Applicant best understands, the Examiner points to Johnston, at Fig. 2, to satisfy this limitation. *See* Current Action, pg. 2. Johnston, at col. 2 lines 39-41, discloses "the amplifying circuit 10 includes an operational amplifier 11 with first and second input terminals 12 and 14 and a single output terminal 16." Clearly, windings 26 (which the

Examiner equates to an auxiliary conductor) are not coupled to amplifier output terminal 16. Instead, only windings 20 and 22 (which the Examiner equates to a primary conductor) are coupled to amplifier output terminal 16. *See Johnston, Fig. 2.* As such, according to the Examiner's own interpretation, Johnston fails to teach or suggest at least an amplification component with an output connect to an auxiliary conductor as recited in claim 1. Moreover, Taikei is not relied upon to teach or suggest this missing limitation. Therefore, the Examiner's proposed combination fails to teach or suggest every claim element of Applicant's invention. Therefore, Applicant requests reconsideration and withdrawal of the 35 U.S.C. 103 rejection of record.

Claims 4 and 5 depend from claim 1 and inherit every limitation therefrom. As shown above, the Examiner's proposed combination fails to teach or suggest every limitation of claim 1. Accordingly, claims 4 and 5 set forth limitations not taught or suggested by the Examiner's proposed combination in their own right. Also, claims 4 and 5 are patentable at least for the reasons set forth above with respect to claim 1.

Conclusion

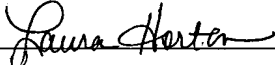
Applicant thanks the Examiner for the indication that claims 2, 3, 6-12, and 14-20 contain allowable subject matter.

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-1078, under Order No. 10030059-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail, Airbill No. EV56825550US in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

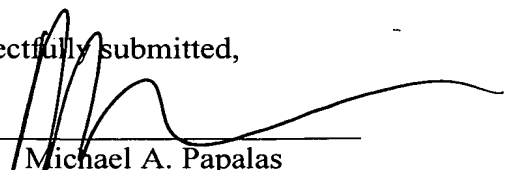
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